

REMARKS

This response is a full and complete response to the Final Office Action, mailed November 20, 2007. In this Final Office Action, the Examiner has noted that claims 1-14, 16, 18, and 22-25 are pending, that claims 1, 5-7, 9, 11-12, and 25 are rejected under 35 U.S.C. § 102, that claims 2-4, 8, 10, and 22-23 stand rejected under 35 U.S.C. § 103, and that claims 13, 14, 16, 18, and 24 have been allowed.

Reconsideration of the above-referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

Status of the Claims:

Claims 1-14, 16, 18, and 22-25 are pending.

Claims 15, 17, and 19-21 were cancelled in a previous response.

Claims 1-6, 8-14, 16, 18, 22-25 have been amended. It is noted that many of these amendments, such as to allowed claims 13, 14, 16, 18 and 24 are merely addressed to formal matters. It is noted further that the foregoing amendments to the claims do not narrow the scope of the pending claims. Rather, the amendments either do not affect claim scope or, in many cases, broaden claim scope. Therefore, it is believed that no prosecution history estoppel results from the foregoing amendments.

Claim 7 is previously presented.

Preliminary Issues

The Action cites and applies U.S. Patent No. 6,122,654 to Zhou et al. ("Zhou"); and U.S. Patent No. 4,791,597 to Miron et al. ("Miron").

It is noted that Assignee does not acquiesce to the positions taken by the Examiner in the above-referenced Final Office Action. For example, Assignee does not agree with the Examiner's position regarding the term "scaling." Nonetheless, this issue is rendered moot in light of Assignee's remarks below.

It is also noted that Miron does not constitute "admission Prior Art" by Assignee, which the Examiner states on page 2 of the office action. Rather, Miron was submitted in an Information Disclosure Statement by Assignee. Such submission is not intended to constitute and, likewise, does not constitute an admission by Assignee.

Claim Rejections under § 102

In paragraph 2 of the Office Action, claims 1, 5-7, 9, 11-12, and 25 are rejected under 35 USC § 102 as being anticipated by Zhou. In response, Assignee respectfully traverses the basis of such rejection. For at least the reasons set forth below, Assignee submits that claims 1, 5-7, 9, 11-12, and 25 are not anticipated by Zhou.

The amended claims are at least distinguishable over the applied Zhou document.

The Manual of Patent Examining Procedure ("MPEP"), in § 2131, states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 869 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Thus, under 35 U.S.C. § 102, a claim is anticipated *only if* each and every element of the claim is found in the applied document.

Zhou does not describe or show each and every element of independent claims 1 and 25. For example, Zhou fails to describe an input signal compliant with at least one specification selected from IEEE 802.11a WLANs or HIPERLAN/2, as presently claimed in independent claims 1 and 25. Accordingly, the Examiner's rejection is respectfully traversed.

Because Zhou fails to show or describe each and every element of independent claims 1 and 25, the Examiner's rejection should be withdrawn. Similarly, because claims 5-7, 9 and 11-12 depend from independent claim 1, the Examiner's rejections to these claims should also be withdrawn.

Claim Rejections under 35 U.S.C. § 103

In paragraphs 3 and 4 of the Office Action, claims 2-4, 8, 10, 22-23 were rejected under 35 U.S.C. § 103 as being unpatentable over Zhou in view of Miron. For at least the reasons set forth below, Assignee submits that such claims are not rendered obvious by the applied documents. Therefore, these rejections are also traversed.

The Examiner is reminded that to successfully make a prima facie rejection under 35 USC § 103, the Examiner must show that Assignee's claimed subject matter would have been obvious to one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See, KSR International, Co. v. Teleflex, Inc., 550 U.S. ____ (decided April 30, 2007). Some of the factors to consider in this analysis include the differences between the applied documents and Assignee's claimed subject matter, along

with the level of skill associated with one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See, USPTO Memo entitled "Supreme Court decision on KSR Int'l. Co., v. Teleflex, Inc.," (May 3, 2007). One way in which an Examiner may establish a prima facie case of unpatentability under 35 USC § 103 would be to show that three basic criteria have been met. First, the Examiner should show that the applied documents, alone or in combination, disclose or suggest every element of Assignee's claimed subject matter. Second, the Examiner should show that there is a reasonable expectation of success from the proposed combination. Finally, the Examiner should show that there was some suggestion or motivation, either in the applied documents themselves or in the knowledge generally available to one of ordinary skill in the art pertinent to the claimed subject matter at the relevant time, to modify the document(s) or to combine document teachings. The motivation or suggestion to make the proposed combination and the reasonable expectation of success should be found in the prior art, and should not be based on Assignee's disclosure. See, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); See MPEP § 2142; 2143 - § 2143.03 (regarding decisions pertinent to each of these criteria). It is respectfully asserted that the Examiner has not met these standards.

First, whether viewed individually or in combination, Zhou and Miron do not suggest or describe all of the claimed elements of the rejected claims. For example, as discussed above, Zhou fails to describe an input signal compliant with at least one specification selected from IEEE 802.11a WLANs or HIPERLAN/2. Furthermore, Miron fails to cure this deficiency. Accordingly, because Zhou and Miron, whether viewed individually or in combination, fail to suggest or describe each and every element of the rejected claims, the

Examiner's rejection of claims 2-4, 8, 10, 22-23 is respectfully traversed and should be withdrawn.

It is noted, therefore, that this situation is not at all like the situation in KSR v. Teleflex, cited previously, because in that case it was determined that a motivation for the proposed combination did exist. Here, even if we assume that is the case, which is not conceded, still the proposed combination would fail to provide all the elements of the rejected claims.

Second, there is no motivation to combine Zhou and Miron. Zhou teaches a complex **multiplication circuit for multiplying** a complex input signal by a complex multiplier. [See e.g., Zhou, col. 1, lns. 5-10] On the other hand, Miron teaches a **multiplierless** FIR digital filter for a VLSI chip. It is clear that a multiplierless FIR filter teaches away from a multiplication circuit for multiplying and, therefore, the two applied documents may not be properly combined. To be more specific, one of ordinary skill looking for a multiplication circuit would have no motivation to turn to a multiplierless filter. Conversely, one of ordinary skill looking for a multiplierless filter would have no motivation to turn to a multiplication circuit for multiplying. Accordingly, the asserted combination is not proper.

It is noted that claimed subject matter may be patentably distinguished from the applied documents for additional reasons; however, the foregoing is believed to be sufficient to overcome the Examiner's rejections discussed above. Further, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those

asserted positions. Rather, the Examiner's positions that are not addressed expressly are believed to be moot in light of the foregoing.

Conclusion

The foregoing is submitted as a full and complete response to the Final Office action mailed **November 20, 2007**. In view of the foregoing amendment and remarks, Assignee respectfully submits that pending claims are in condition for allowance and a notification of such allowance is respectfully requested.

If the Examiner believes that there are any remaining informalities, which can be corrected by an Examiner's amendment, a telephone call to the undersigned at 503.439.6500 is respectfully solicited.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 50-3130.

Respectfully submitted,

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I hereby certify that this correspondence is being transmitted via EFS, facsimile or deposited with the United States Postal Service with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

February 19, 2008
Date


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